



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/529,266

10/03/2005

Xavier Blin

05725.1421-00

4160

22852

7590

10/20/2009

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

ORWIG, KEVIN S

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

10/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/529,266	Applicant(s) BLIN ET AL.	
	Examiner Kevin S. Orwig	Art Unit 1611	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 September 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 77-80,83-94,97-107 and 109-161.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/David J Blanchard/
Primary Examiner, Art Unit 1643

Continuation of 11. does NOT place the application in condition for allowance because: The arguments presented by applicants are unpersuasive for at least the following reasons.

In the amended claims, applicants have done nothing more than rearrange previously presented limitations, which were properly rejected previously. The previously applied combination of references discussed below still properly reject the instant claims.

REJECTIONS WITHDRAWN:

The rejection of claims 104-107 under 35 U.S.C. 112, first paragraph (New Matter), is withdrawn in light of the claim amendments.

The rejection of claims 77-80, 83-94, 97-107, and 109-161 under 35 U.S.C. 112, second paragraph, is withdrawn in light of the claim amendments.

The rejection of claims 77-80, 83-84, 86-94, 98-103, and 159-161 under 35 U.S.C. 103(a) over MOUGIN (U.S. 2002/0115780; Ref. #7 on IDS dated Jul. 19, 2006) in view of FRECHET (U.S. 6,663,855; Ref. # 63 on IDS dated Mar. 10, 2009) and MELCHIORIS (U.S. 6,531,535; Ref. #61 on IDS dated Mar. 23, 2009) is withdrawn in light of the claim amendments.

REJECTIONS MAINTAINED:

The double patenting rejections of record are maintained at the present time (see note below).

Claims 77-80, 83-94, 97-107, and 109-161 are rejected under 35 U.S.C. 103(a) as being unpatentable over ANTON (U.S. 6,153,206; Ref. #35 on IDS dated Jul. 19, 2006) in view of FRECHET (U.S. 6,663,855; Ref. #63 on IDS dated Mar. 23, 2009) and MELCHIORIS (U.S. 6,531,535; Ref. #61 on IDS dated Mar. 23, 2009).

RESPONSE TO ARGUMENTS:

Applicants argue that the intermediate segment of the claimed block polymers is a random copolymer and allege that Anton and Frechet do not teach such a structure. Applicants argue that the preferred polymers of Frechet do not cure the alleged deficiencies of Anton.

Applicants argue that Frechet does not describe how to make the polymers it teaches and broadly assert that because Frechet is allegedly silent as to the Tg of R, the intermediate block does not have a Tg as instantly claimed.

As admitted by applicants, Anton teaches block polymers of varying architectures. It is noted that the central segment of a block copolymer such as that taught by Anton (IIIIIIIBBBBBBB) can be construed as a random block. For example, the segment IIBB that connects the IIIII and BBBBB blocks is a random copolymer. Because a random copolymer does not exclude this structure, Anton itself reads on the claim. However, Frechet clearly teaches the instant structure of the intermediate block along with the claimed Tg values (see paragraph 9 of the prior Office Action). Applicants are reminded that a reference is good for all it teaches and is not limited to preferred embodiments. The totality of Frechet's teachings clearly encompass the instantly claimed Tg values. Applicants have provided absolutely no evidence to support their assertion that the Tg of the intermediate segments taught by Frechet (or Anton) could not have a Tg as instantly claimed nor has any evidence been provided to support the implication that an artisan would not know how to make the polymers taught by Frechet.

Applicants argue that some monomers taught by Mougin and Frechet would yield unpredictable results in terms of polydispersity.

Applicants are reminded that all that is required to meet the claim language is a recognition in the art that polydispersity values greater than 2.5 have been useful in similar applications, which teaching is taught by Melchioris. Applicants state that the various examples of Melchioris have different properties based on monomers and production processes. Applicants have not established that these differences are due to the polydispersity of the resultant polymers, and Melchioris does not teach this. MPEP 2144.08 states "However, obviousness does not require absolute predictability, only a reasonable expectation of success, i.e., a reasonable expectation of obtaining similar properties." Applicants attention is drawn to examples 1-4 of Table 1, all of which have polydispersities of greater than 2.5, and all of which have excellent solvent resistance, hardness, and gloss. Melchioris clearly establishes a reasonable expectation of success even if, in arguendo, some unpredictability is apparent. Again, no actual evidence has been presented to establish that any of the monomers of Anton or Frechet would be unpredictable.

TERMINAL DISCLAIMERS

The four terminal disclaimers submitted by applicants are acknowledged. At this time, the terminal disclaimers are awaiting review by the USPTO legal staff and have not yet been approved. Thus, the double patenting rejections are maintained until such approval is given.